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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,713	06/14/2005	Walter Haussecker	022862-1041	2416
23409 7590 02/22/2010 MICHAEL BEST & FRIEDRICH LLP 100 E WISCONSIN AVENUE Suite 3300 MILWAUKEE, WI 53202				
EXAMINER				
LUONG, VINH				
ART UNIT		PAPER NUMBER		
3656				
MAIL DATE		DELIVERY MODE		
02/22/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/540,713

**Applicant(s)**

HAUSSECKER ET AL.

**Examiner**

Vinh T. Luong

**Art Unit**

3656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-21 and 23 is/are pending in the application.
- 4a) Of the above claim(s) 2,6,11-13,15-17,19 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,5,7-10,14,18,20 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 October 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Proficiency Review (PTO-544)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

1. The amendment filed on October 27, 2009 has been entered.
2. Claims 2, 6, 11-13, 15-17, 19, and 21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on March 10, 2009.
3. The drawings were received on October 27, 2009. These drawings are accepted by the Examiner.
4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear whether the term that appears twice, such as, "an armature shaft" in claim 9 refers to the same or different things. Please see double inclusion in MPEP § 2173.05(o).

6. Claims 1, 4, 5, 7, 8, 10, 14, 18, 20, and 23, and claim 9, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hager et al. (WO 01/61133 A1) in view of Coleman (US 6,345,925).

Claims 1 and 9

Hager teaches a drive unit (FIG. 1) for actuating drives in a motor vehicle with a first housing part 2 and a second housing part 15 connected to the first housing part 2 by means of connecting elements 4, wherein the first housing part 2 features receptacles 5 for the connecting elements 4, and the first and second housing parts 2 and 15 are assigned bearing functions for an armature shaft 14.

Hager teaches the invention substantially as claimed. See translation attached. However, Hager does not teach the receptacles embodied as centering holes for corresponding centering pins arranged on the second housing part and the second housing part featuring counter receptacles for the connecting elements surrounding at least partially by the centering pins.

Coleman teaches the receptacles 32 embodied as centering holes 32 (FIG. 3) for corresponding centering pins 94, 96 arranged on the second housing part 18 and the second housing part 18 featuring counter receptacles 38 for the connecting elements 16 surrounding at least partially by the centering pins 94, 96 in order to improve the strength of the connection of the housing part. Coleman 1:1-7; 11:44-65.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the receptacles embodied as centering holes for corresponding centering pins arranged on Hager's second housing part and Hager's second housing part featuring counter receptacles for Hager's connecting elements surrounding at least partially by the centering pins in order to improve the strength of the connection of Hager's first and second housing parts as taught or suggested by Coleman.

The modification of Hager's drive unit by forming the receptacles for corresponding centering pins as taught or suggested by Coleman would not have been uniquely challenging to a person of ordinary skill in the art because it is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement" *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) and it "does no more than yield predictable results." *KSR* at 1739.

Claim 4

Coleman's centering pins 94, 96 embodied to be sleeves (FIGS. 3 and 13A).

Claims 5 and 14

See lead-in bevels formed on Coleman's centering pins 94, 96 in, e.g., FIG. 13A.

Claims 7 and 18

Hager teaches the centering (bore) holes (not shown) arranged as through bore holes in a flange (Spec., ¶ 3). To choose the thickness of Hager's centering holes such that it is greater than the height of the centering pin would have been a matter of choice in design since the claimed structures and the function they perform are the same as the prior art. *In re Chu*, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995) citing *In re Gal*, 980 F.2d 717, 719, 25 USPQ2d 1076, 1078 (Fed. Cir. 1992). See also *stare decisis* regarding changes in size or proportion in MPEP § 2144.04.

Claims 8 and 20

Coleman's centering pin 94, 96 forms a clearance fit together with the centering holes 32 (FIGS. 3 and 13A).

Claim 10

Hager's centering bore holes include pocket or through holes. See Applicant's admission in Spec., ¶ 3 quoted below:

"The pole pot is composed of a deep-drawn, smoothed-down, cylindrical tube on whose open end a flange is formed in which holes to accommodate screws are left open. Formed in the flange of the gear housing are *pocket threads into which the screws are screwed* thereby solidly connecting the two parts of the housing with one another." (Emphasis added).

Claim 23

See claim 1 above. In addition, it is common knowledge in the art to form the centering pins and the housing part in the drive unit of Hager as modified by Coleman as one unitary piece by injection molding in order to, e.g., improve the cost of manufacturing. See MPEP § 2144.04 citing *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) (the use of a one piece construction instead of the structure disclosed in [the prior art] would be merely a matter of obvious engineering choice.”). On the one hand, it is well settled that the determination of patentability is based on the product itself, not by its method of production, such as, injection molding. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985); *SmithKline Beecham Corp. v. Apotex Corp.*, 78 USPQ2d 1097 (Fed. Cir. 2006); and MPEP § 2113.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the centering pins and the housing part in the drive unit of Hager as modified by Coleman as one unitary piece by injection molding in order to, e.g., improve the cost of manufacturing as taught or suggested by common knowledge in the art. *KSR*.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Frerejacques (FIG. 2) and Glen et al. (centering pins 60).
8. Applicant's arguments filed October 27, 2009 have been fully considered but they are not persuasive.

### **Objections**

The objections are withdrawn in view of the amendments and replacement drawings.

### **35 USC 112**

The previous rejection under 35 USC 112, ¶ 2<sup>nd</sup> is withdrawn in view of the amendments.

### **35 USC 102 & 103**

The previous rejection of claims 1, 3, 7, 10, 18, and 22 under 35 USC 102(b) as being anticipated by Hager and the rejection of claims 4, 5, 8, 14, and 20 under 35 USC 103 as being unpatentable over Hager in view of Nolte are withdrawn in view of Applicant's amendments to the claims. Applicant's arguments with respect to claims 1, 4, 5, 7-10, 14, 18, 20, and 23 have been considered but are moot in view of the new ground(s) of rejection.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday, Tuesday, Thursday, and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vinh T Luong/  
Primary Examiner, Art Unit 3656